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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/280,528 03/30/99 CORDERY

R E-831

EXAMINER

DIXON, T

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 08/08/01

TM02/0808
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/280,528

Applicant(s)

CORDERY ET AL.

Examiner

Thomas A. Dixon

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1,8,9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,10-13,25 and 28 is/are rejected.
- 7) ☒ Claim(s) 2-6,14-24,26,27,29 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-13 were originally presented, pre-amendment A, paper #5, of 14 June 1999, cancelled claims 1,8,9 and added claims 14-30.

Specification

2. The specification is objected to because:

Applicant is informed that the use of underlining and square brackets is improper, these symbols are used by the printer to indicate insertions and deletions, and as such, would cause confusion and possible deletion of critical material from the specification;

page 1, lines 5,6 have blank lines referring to co-pending applications, which should contain the application numbers.

page 3, lines 13 and 17, should contain the current status of the applications, as patented files, with their Patent numbers.

Correction is required.

Claim Objections

3. Claims 2-5,14-24,26,27,29 and 30 are objected to because they are in improper form. Specifically, regarding claims 5,14,15,16,17,21,23,24,26, and 29, applicant is informed that the use of underlining and square brackets is improper, these symbols are used by the printer to indicate insertions and deletions, and as such, would cause confusion and possible deletion of critical material from the claims.

Claim 10 is objected to because the last line is indented as if a word is missing which cannot be read.

Claim 12 is objected to because the text of line 8 cannot be easily read.

Claim Rejections - 35 USC § 112

4. Claim 6 recites the limitation "the method described in claim 1" in line 1. Claim 1 has been cancelled, therefore, there is insufficient antecedent basis for this limitation in the claim.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 7, 10-13, 25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Pauschinger (6,041,704).

As per Claim 7.

Pauschinger ('704) discloses:

- a) a signature generated with a private key of a first party, see column 5, lines 30-31;
- b) a certificate, see column 5, lines 24-29;
- c) information specifying attributes of said article, see column 5, lines 31-32; wherein
- d) said private key of said first party is generated as a function of said certificate, said information and a private key of a certifying authority, see column 5, lines 23-40.

As per Claim 10.

Pauschinger ('704) discloses:

- a) certifying authority providing said meter with an integer, said integer being a first function of said private key of said authority, see column 5, lines 23-31;

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b) said meter computing a digital postage meter private key as a second function of said integer, see column 5, lines 30-35;

c) said certifying authority publishing related information, see column 5, lines 46-53; wherein

d) said first function, said second function and said published related information are chosen so that a party seeking to verify said indicia can compute said digital postage meter public key by operating on said published related information with said published public key of said authority, see column 5, lines 23-40.

As per Claim 11.

Pauschinger ('704) discloses all the limitations of claim 10.

Pauschinger ('704) further discloses published related information includes information identifying said digital postage meter and operating parameters applicable to said postage meter, see column 5, lines 31-35.

As per Claim 12.

Pauschinger ('704) discloses:

a) certifying authority providing a user with an integer, said integer being a first function of said private key of said authority, see column 5, lines 23-31;

b) said user computing a digital postage meter private key as a second function of said integer and downloading said postage meter private key to said digital postage meter, see column 5, lines 30-35;

c) said certifying authority publishing related information, see column 5, lines 46-53; wherein

d) said first function, said second function and said published related information are chosen so that a party seeking to verify said indicia can compute said digital postage meter public key by operating on said published related information with said published public key of said authority, see column 5, lines 23-40.

As per Claim 13.

Pauschinger ('704) discloses all the limitations of claim 12.

Pauschinger ('704) further discloses published related information includes information identifying said digital postage meter and operating parameters applicable to said postage meter, see column 5, lines 31-35.

As per Claim 25

Pauschinger ('704) discloses:

a) generating a message m, said message including indicia data, see column 5, lines 30-35;

b) generating a digital signature with message recovery for said message m, see column 5, lines 30-35; and

c) incorporating a digital signature into said indicium, see column 5, lines 36-40.

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As per Claim 28.

Pauschinger ('704) discloses:

- a) recovering a message m from a digital signature of a postal indicium, see column 6, lines 1-38; and
- b) accepting said signature as valid if said message m is internally consistent, see column , lines 28-31.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EP 0 762 692 A2 to Cordery et al is the closest foreign art, but does not disclose all the limitations of the claims.

"Stamping out fraud" is the closest non-patent literature which discloses the use of certificate authorities for postage and elliptical curve theory for cryptography, but does not disclose all the limitations of the claims.

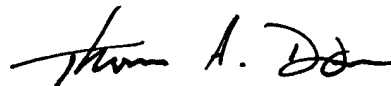
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Friday 7 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.



Thomas A. Dixon
Examiner
Art Unit 2161

August 6, 2001